

REMARKS

OBJECTIONS

Examiner noted that numeral 170 was used to designate both fastening means and inlet means. On page 7 of the specifications, applicants states that "inlet means are implemented using fastening means". Applicant added language in specification to state that inlet means are implemented as fastening means.

FIG. 12 was replaced with the numeral 126 changed to 129. FIG. 15 has been replaced with the numeral 317 pointing to the right edge and numeral 315 having a lead line. The numeral 135 designated as an opened position on page 9 of the specifications was deleted. FIG. 11 was replaced with numerals 229 and 231 corrected. Examiner noted that upper opening (115) was incorrect on page 10 of the specifications. Applicant deleted sentence and added a more appropriate sentence disclosed in FIG. 20 and 21. Applicant amended Abstract to correct limit.

112 REJECTIONS

The examiner rejected claims 7-9 and 13-21 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Regarding claim 7 applicant amended the bottom section to the lower section as defined in claim 1. Regarding claim 8 applicant amended the bottom panel to the lower section as defined in claim 1. Regarding claim 13, 15, 16, applicant amended

each of the before mentioned claims to refer back to claim 10 thereby defining the back panel. Regarding claims 17, 18, and 20, "at least one side panel" is defined.

103 REJECTIONS

Examiner noted that claims 1 and 6 were rejected under 35 USC 103 (a) as obvious in view of Bowen et al.

Examiner noted that claim 22 was rejected under 35 USC 103 (a) as obvious in view of Moyer.

Examiner noted that claims 1, 6, 8 and 9 were rejected under 35 USC 103 (a) as obvious in view of Meyers.

Examiner noted that claims 4 and 5 were rejected under 35 USC 103 (a) as obvious in view of Landes.

Examiner noted that claims 11, 12, 20 and 21 were rejected under 35 USC 103 (a) as obvious in view of Foxcroft.

Examiner noted that claim 15 was rejected under 35 USC 103 (a) as obvious in view of Allen.

Examiner noted that claims 18 and 19 were rejected under 35 USC 103 (a) as obvious in view of Battye.

Examiner noted that claim 23 was rejected under 35 USC 103 (a) as obvious in view of Oh.

Here, Claim 2 was objected to but would be allowed if rewritten in independent form. Thus, Claim 2 was cancelled and incorporated into claim 1 to place the claims in a condition for allowance.

Claims 24-31 were added to claim the concept of a traveling bag cover. The rejection of claim 23 along with the newly added claim rejection will be traversed below.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990))

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination (See *In re Geiger*, 815 F2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)).

There must be some reason given the prior art why one of ordinary skill in the art would have been prompted to combine the teachings of the references to arrive at the claimed invention. (See *In re Regel* 188 USPQ).

There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention....Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success....Such as a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved. (See

Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc., 183 F.3d 1347, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999)

The invention that was made, however, does not make it self obvious; that suggestion or teaching must come from the prior art. *See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination). (See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)).

Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. (*See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). Lacking a motivation to combine references, the Board did not show a proper *prima facie* case of obviousness. (*See In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed.Cir.1998)).

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is

proper. . . Absent such reasons or incentives, the teachings of the references are not combinable. (See *Ex parte Skinner*, 2 U.S.P.Q 2d 1788) Examiner cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention.

Here, regarding claim 7, the applicant claims a rigid bottom panel with

Regarding claim 11, the releasable fastening means is affixed horizontally across the back panel at an intermediate location. Foxcroft discloses a releasable fastening means across the back panel for a box without a bottom with an opening and Sackstein discloses the releasable fastening means in the bottom panel for hand luggage without an opening in the bottom for wheels or stand. Numeral 14 are studs added to prevent the cover from being scratched when set down.

Regarding claim 13, the releasable fastening means is affixed vertically across an intermediate location dividing the back panel. Sackstein discloses the releasable fastening means in the bottom panel for hand luggage without an opening in the bottom for wheels or stand. Numeral 14 are studs added to prevent the cover from being scratched when set down. Thus, Sackstein does not disclose this element of the claims.

Regarding claim 15, the releasable fastening means is affixed to the edges of the back panel. Allen discloses a slide fastener 17 in the top panel with flap 19 across. Thus, Allen does not disclose the fastening means of claim 15.

Regarding claim 16, the releasable fastening means is affixed to the edges of the upper panel. The fastening means of claim 16 is not disclosed in the prior art of record.

Regarding claim 17, the releasable fastening means is affixed to the edges of a side panel. The fastening means of claim 17 is not disclosed in the prior art of record.

Regarding claim 18, the releasable fastening means is affixed vertically across a side panel. In Bayte the fastening means are disclosed across the top panel and there is no opening in the bottom for wheels.

Regarding claim 20, the releasable fastening means is affixed horizontally across a side panel. Foxcroft discloses a releasable fastening means across the back panel for a box without a bottom with an opening and Sackstein discloses the releasable fastening means in the bottom panel for hand luggage without an opening in the bottom for wheels or stand. Numeral 14 are studs added to prevent the cover from being scratched when set down.

Regarding claim 23, the upper panel is divided into two sections each having a slot into which the handle goes. Oh discloses an integrated protective cover. Bayte discloses a top panel that overlaps with slots for handles. Examiner has found a prior art that has an element of the claim, but has not given a reason or motivation for combination.

Examiner states that it would be obvious to combine but does not give a stated reason why one in the prior art would combine Oh and Bayte to form a functional protective cover. Additionally, why one skilled in the art would incorporate the slots of Bayte into the upper panel of Oh when each protective cover serves a different functionality.

In regards to claims 11, 13, 15, 17, 18 and 20 stated above the examiner has found elements of the claimed invention in the prior art. However, again the examiner states that it would be most obvious to combine Bowen with the above mentioned prior art (i.e.

Foxcroft, Sackstien, Allen, Bayte, and Meyers) without providing the reasoning or understanding for the combination. The court has held that an examiner cannot “use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (See **In re Fine**, 837 F2d 1071 Fed. Cir. 1988)). Thus, the court has held that an isolated disclosure in the prior art of a claimed element does not automatically generate a reason or motivation for combination. A reason for combination must be clearly stated. “Broad conclusory statements regarding the teaching of multiple references, standing alone is not evidence”. (See **Dembiczak**, 175 F.3d 994 (Fed. Cir.1999)). The court has held that hindsight is an improper rejection reason for non-obviousness. Therefore, applicant added claim 24-31 to reclaim the subject matter that was rejected in claims 1, 10, 11, 13, 15, 16, 17, 19, and 20.

Applicant respectfully requests that the rejections be withdrawn. Alternately should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned.

Respectfully submitted:



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CERTIFICATE OF MAILING AND FACSIMILE

I, Delphine James, hereby certify that the foregoing Response to the Office Action is being Facsimile transmitted to the Patent and Trademark Office to facsimile number 571-273-8300.

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